

DBT-002

DOC. ID
DBT002I

- 13 -

REMARKS**Drawing Objection - 37 CFR 1.83(a)**

1. The Examiner's objection to the drawings because "banner display means having a menu display means for presenting a menu of navigation options when an end-user clicks on said banner" is not shown, has been studied and the Applicant respectfully disagrees for the following reasons. The Applicant refers the Examiner to page 11, second paragraph, beginning at line 23 which reads as follows:

A graphical user interface 211 enables the advertising module to read an image file 212 and to display a banner image 235 to the consumer end-user on the screen of an end-user computer 14.

The Applicant further refers the Examiner to page 11, second paragraph, beginning at line 27 which has been amended to read as follows:

The communications interface 214 also provides notification to the advertising module 210 from the hosting HTML document or application 220 of any consumer end-user actions upon the displayed banner image 235 (as illustrated in FIGS. 5A and 7A), i.e., clicking or similar events. When an end-user clicks on a displayed banner image 235 of the present invention, the method of the present invention will cause the advertising module to read the data from the hotlink script 213 which contains the set of hotlink navigation options, specified by the advertiser when the advertising module was created.

These sentences clearly indicate that the advertising module displays a banner image 235 to the consumer end-user on the screen of an end-user computer 14, the means is, thus,

DBT-002

DOC. ID
DBT002I

- 14 -

clearly shown as the banner image 235 on the screen of the end-user computer 14 in FIGS. 5A and 7. FIG. 7 clearly shows that when the banner 235 is clicked on a menu of navigation options is presented. If the Examiner believes that the wording of the Claims or the Specification do not accurately reflect the Applicant's contention and intention or accurately describe the Figures, the Applicant is open to amend either and would gratefully consider any suggestions the Examiner may offer. The Applicant respectfully submits that the Examiner's objection to the drawings has been overcome by the amendment to the Specification and the remarks above.

Claim Rejections - 35 USC §101

2. The Examiner's rejection of Claims 1-27 under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter has been studied and the Applicant has amended Claim 1, from which Claims 2-27 depend, so that the claimed software is embodied on some form of computer readable medium as required. The Applicant respectfully submits that the Examiner's rejection of Claims 1-27 under 35 U.S.C. 101 has been overcome by the amendment to Claim 1 and the remarks above.

Claim Rejections - 35 USC § 103

3. The Examiner's rejection of Claims 1-29, 31-34, 36-37, and 40-53 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,141,010 to Hoyle in view of U.S. Patent No. 6,587,118 to Yoneda and further in view of U.S. Patent No. 6,642,946 to Janes et al., has been carefully studied and the Applicant respectfully disagrees with the Examiner because there is an absence of features of the presently claimed invention and there is not even a suggestion in the cited references that would lead one skilled in the art to combine these three references. The Examiner states that Hoyle does not explicitly teach a menu of navigation options when an end-user clicks on said banner.

The Examiner contends that Yoneda teaches a menu display means for presenting a menu of navigation options when an

DBT-002

DOC. ID
DBT002I

- 15 -

end-user clicks on a graphic (Figures 3A and 3B and col. 7, lines 31-50). The Applicant respectfully disagrees with this contention. The Applicant refers the Examiner to column 4, lines 19-24 of Yoneda.

FIGS. 3A, 3B, and 3C illustrate examples of manners in which an HTML file acquired from the WWW server 1 is displayed on the display screen 29 such that a text (ABCDEFGH . . . XYZ) of a home page and a menu bar 30 are superimposed. In FIG. 3A, the menu bar 30 is displayed in such a manner that only its index 30i is displayed.

The menu bar is displayed such that its index is displayed but Yoneda does not teach to display the menu bar or its index by clicking. Referring to Yoneda col. 7, lines 31-50, the program only determines whether Menu1 or Menu2 on the menu bar 30 displayed on the CRT 18 is clicked with the mouse 17. Yoneda does not teach clicking on a banner or a graphical interface that presents a menu of navigation options when an end-user clicks on said banner because the navigation options, Menu1 and Menu2, are already displayed before they are clicked on. Yoneda teaches clicking on the Menu1 or the Menu2 not the graphic such as or similar to a banner. As clearly proven above, Yoneda fails to teach "a menu display means for presenting a menu of navigation options when an end-user clicks on the banner and at least a portion of the navigation options are URLs on a network to which an end-user computer is connectable". Thus, one element in all of the Claims is not disclosed or taught in the prior art, this missing element is "a menu display means for presenting a menu of navigation options when an end-user clicks on said banner".

The Examiner stated that "It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hoyle regarding banner publishing software with the teachings of Yoneda regarding the presentation of a menu of multiple navigation options when an

DBT-002

DOC. ID
DBT002I

- 16 -

end user clicks on a graphic because a publisher could want a banner to reflect multiple options for navigating information based on geographic preferences as in the Janes reference (Figure 2A and col. 4, line 48 - col. 5, line 14)." The Applicant respectfully submits that "could" is not a valid reason for combining references for the purpose of a 103 obviousness rejection and, in fact, it is evidence that the Examiner used impermissible hindsight in making the rejection. The Applicant respectfully submits that such a rejection has no basis in law and is impermissible and the Examiner used hindsight in making the rejection.

The Applicant refers the Examiner to the MPEP 706.02(j) "Contents of a 35 U.S.C. 103 Rejection - 700 Examination of Applications" 706.02(j) Contents of a 35 U.S.C. 103 Rejection 35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the Examiner should set forth in the Office Action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,

(B) the difference or differences in the claim over the applied reference(s),

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art, at the time the invention was made, would have been motivated to make the proposed modification.

The Examiner has failed to give any reason or motivation

DBT-002

DOC. ID
DBT002I

- 17 -

found in the references to combine the references as required by the MPEP and the law.

The MPEP further states "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

The MPEP states that the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done and that to support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Clearly, the Examiner used impermissible hindsight to make the combination for the 103 rejections. It would appear that the Examiner has no basis in fact or anything even suggested in the prior art to arrive at the conclusion that "It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Hoyle regarding banner publishing software with the teachings of Yoneda regarding the presentation of a menu of multiple navigation options when an end user clicks on a graphic because a publisher could want a banner to reflect multiple options for navigating information based on geographic preferences as in the

DBT-002

DOC. ID
DBT002I

- 18 -

Janes reference (Figure 2A and col. 4, line 48 - col. 5, line 14).".

It is clear, as evidenced by the Examiner's statements that fail to cite any reason in any of the references to combine the cited references, that this rejection is based on impermissible hindsight. The court clearly teaches us that a conclusion of obviousness is an error when it is not accompanied by a clearly elucidated factual teachings, suggestions, or incentives from this prior art that shows the propriety of combination. Here, the Examiner has taken three references and combined them without any reason disclosed or even suggested in the prior art with the only reason for combining them being they "could" be combined.

The CAFC in *In re Rouffet* (CAFC) 47 USPQ2d 1453 (7/15/1998) stated "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness." In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In other words, "the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. The Board's naked invocation of skill in the art to supply a suggestion to combine the references cited in this case is therefore clearly erroneous. Absent any proper motivation to combine part of Levine's teachings with Freeburg's satellite system, the rejection of Rouffet's claim over these references was improper and is reversed."

Thus, the Applicant respectfully submits that the amendments and remarks above overcome the Examiner's rejections of Claims 1-29, 31-34, 36-37, and 40-53 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,141,010 to Hoyle in

DBT-002

DOC. ID
DBT002I

- 19 -

view of U.S. Patent No. 6,587,118 to Yoneda and further in view of U.S. Patent No. 6,642,946 to Janes et al., because one of the elements of the Claims is not found in the prior art and that the Examiner has failed to provide the proper basis or a valid reason for combining the cited references for the purpose of a 103 obviousness rejection and in fact has used impermissible hindsight in making the rejection. The Applicant respectfully submits that these Claims are in condition for allowance.

The Applicant respectfully disagrees with the Examiner's assertion that, as to the rejection of Claims 34 and 53, Hoyle teaches an alerting means for alerting the end-user that the banner software has been changed on the end-user computer. Claims 34 and 53 include "an alerting means for alerting the end-user that the banner software has been changed on the end-user computer." The Applicant cannot find any indication of such an alerting means in either the Hoyle or Gennaro patents. There is nothing in either reference to alert the user that banner has been updated or changed enticing the user to go to the banner and see the change such as in the present Claims.

In summary, the Applicant respectfully submits that there is an absence of features of the present Claims in the cited references and there is not even a suggestion in the cited references that would lead one skilled in the art to combine the Gennaro and Hoyle references. Neither Gennaro or Hoyle teach or disclose "a menu display means for presenting a menu of navigation options when an end-user clicks on the banner and at least a portion of the navigation options are URLs on a network to which an end-user computer is connectable". Therefore, the Applicant respectfully submits that the Examiner's rejection of Claims 2-27, 29, 31, 33-34, 42-48, and 50-53 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,742,768 to Gennaro et al., in view of U.S. Patent No. 6,141,010 to Hoyle, has been overcome by the remarks above.

4. As to the Examiner's rejection of Claim 37 in which the

DBT-002

DOC. ID
DBT002I

- 20 -

Examiner contends that Hoyle teaches an alerting means for alerting the end-user that the message has been sent to the end-user computer (col. 11, line 50 - col. 12, line 26) that displaying a banner is considered alerting the user of a message, the Applicant respectfully disagrees. The Examiner's statement that displaying a banner is considered alerting the user of a message ignores the clear meanings and distinctions between the definitions of banner and message. Both Hoyle and the present Application discuss banners and the information they contain. A message sent to an end user is not a banner and nothing in Hoyle states otherwise. Claim 52 clearly states and claims a means for displaying said message when said banner is displayed on a screen on an end-user computer. The Applicant clearly has distinguished between banners and messages as clearly evidenced by the terms used and their obviously different functions. The Examiner's reasoning would lead one to display one banner while another banner is displayed, this clearly not taught by Hoyle. The Examiner's reasoning that displaying a banner is considered alerting the user of a message ignores the obvious and clear meaning of message as understood by one skilled in the art and explained in the specification and drawings of the present Application and ignores the fact that Hoyle fails to make any similar distinction.

5. As to the Examiner's rejection of Claim 52 in which the Examiner contends that Hoyle teaches messaging software operable on a server computer for producing and sending a message that appears on the screen of end-user computers having banner software installed and a means for displaying said message when said banner is displayed on a screen on an end-user computer (col. 13, line 44 - col. 14, line 5) the Applicant respectfully disagrees. The Applicant sees nothing in column 13 -14 that suggests sending a message and as explained above respectfully submits that banners and messages, as clearly evidenced by the terms used, are obviously different terms having different functions and are not in any way the same nor are they

DBT-002

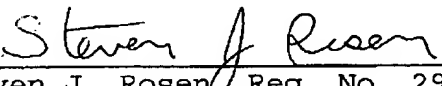
DOC. ID
DBT002I

- 21 -

functionally equivalent as explained above.

6. As to the Examiner's rejection of Claims 34 and 53, in which the Examiner contends that Hoyle teaches an alerting means for alerting the end-user that the banner software has been changed on the end-user computer (col. 16, lines 24-52), the Applicant respectfully disagrees. The Applicant sees nothing in column 16 that suggests an alerting means for alerting the end-user that the banner software has been changed on the end-user computer. The lines cited by the Examiner disclose a two-tiered approach to targeted advertising. The first tier is the initial selection of banners to be downloaded to the user based upon the user's demographic information. The second tier is the reactive targeting of the advertisements based upon user interaction with the computer. The whole process is transparent to the end user who does is never alerted to the change and thus alerting the end-user that the banner software has been changed is contrary to the purpose of Hoyle.

7. Therefore, the Applicant respectfully submits that the Examiner's objections and rejections of Claims 1-66 have been overcome by the remarks above and requests that all pending Claims be passed on to issue.


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